REMARKS

The rejection of claims 5-10 under 35 USC 102(e) from the cited Huang U.S. patent publication is traversed on the basis of the earlier March 1, 2001, filing date of the priority application. In support thereof, a translator-signed English translation of the priority application is being filed.

The rejection of claims 5-11 under 35 USC 103 for obviousness from Applicant's Admitted Prior Art (APA) is traversed because the APA does not disclose the second length being larger than the first length, as admitted in the Action, nor any motivation to provide this.

That it would have been possible, even routinely possible, to try these particular dimensions is insufficient for a rejection.

> "Obvious to try is not the standard of 35 U.S.C. § 103." In re Antonie, 195 USPQ 6, 8 (CCPA 1977) (emphasis omitted). Rather, the test is whether the references, taken as a whole, would have suggested appellant's invention to one of ordinary skill .... In re Merk & Co., Inc., 231 USPQ 375, 379 (Fed. Cir. 1986).

In this case, since there is nothing in the APA to have suggested appellant's invention, and nothing to the contrary is pointed out in the Action, the claimed invention cannot be obvious from the APA.

Instead, the assertion in the Action that "... the thickness of an adhesive can be determined by alternative methods known in the art ..." shows that there is no suggestion in the art to do it the way claimed. If the adhesive thickness can be determined in one, alternative way, there is no motivation from wanting the determination toward another way of the same result. Moreover, if these other ways are thought to suggest the claimed invention,

then the alternative methods known in the art should be made of record as now called for under 37 CFR 1.104(d)(2) so that the Applicant can consider their teachings toward or away from the claimed invention.

While indeed it has been held that mere dimensions are prima facie obvious absent a disclosure of unobvious purpose, unexpected result or critical result, no mere dimensions are claimed in this case. The claimed invention includes instead a relative dimensions (the second length being longer than the first length) as shown by its unitlessness, and the purpose thereof is unobvious, besides, because nothing even in the claim to this complete structure, explains the adhesive-measuring purpose thereof described only in the applicant's specification at page 3, lines 19-25:

> The second length L2 is larger than the first length L1 to expose the opposed longitudinal sides of the plate 23. On overflow adhesive portion 26 is formed between the plate 23 and the second chip 24, and the overflow adhesive portion exposes on the plate 23. Therefore, the testing instrument can detect the size of the overflow adhesive portion 26 and the thickness of the adhesive layer 25 so a to control the quality ....

There is nothing in the relative length dimensions claimed that suggests the therefore unobvious purpose of measuring an adhesive thickness perpendicularly to the lengths, the result of the claimed relative dimensions thus being unexpected, too.

The teaching of the purpose of the claimed invention for the result achieved in the Applicant's specification cannot be used against the Applicant.

> To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference of references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher. W.L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303, 312, 313 (Fed. Cir. 1983).

For these reasons, the applicant believes that the particular unobvious purpose and the unexpected result of the invention have been clearly disclosed in the specification. The prior art and the citations do not teach or suggest the technical features of the invention. Besides the prior art and the citations have not been shown under 37 CFR 1.104(d)(2) to achieve the objective of the present invention.

Reconsideration and allowance are, therefore, requested.

Respectfully submitted,

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